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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/678,766	10/02/2000	Albrecht Dorschner	Beiersdorf 657-KGR	5682

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EXAMINER	
GOLLAMUDI, SHARMILA S	

ART UNIT	PAPER NUMBER
1616	

DATE MAILED: 04/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/678,766	DORSCHNER ET AL.	
	Examiner	Art Unit	
	Sharmila S. Gollamudi	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 January 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *4-23 and 26-29* is/are pending in the application.

4a) Of the above claim(s) *25* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *4-23 and 26-29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Status of Application

Receipt of Applicant's Remarks, Amendments, and Request for Extension of Time received on January 23, 2004 is acknowledged. Claims 4-23 and 26-29 are pending in this application. Claims 1-3 and 24 stands cancelled. Claim 25 is withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Rejection of claims 4-23 and 26-29 under 35 U.S.C. 102(b) as being anticipated by Robinson et al (5,603,923) is maintained.

Robinson et al disclose an artificial tanning oil-in-water emulsion containing an aqueous phase, an oil phase, 1% steareth-20, polysorbate 60, glyceryl stearate, and 3% dihydroxyacetone. See example IV-VI. Example VII-IX teaches 0.45% ceteareth-20. The oil and water phase contain other soluble substances.

Response to Amendments and Arguments

Applicant has amended the claims to recite that the O/W emulsion is obtained by phase inversion induced by varying the pH. Applicant argues that anticipation requires that each and every element is set forth in the claims either inherently or expressly and since the prior art of record does not teach the instant amendment, the art does not read on instant claims.

Applicant's arguments have been fully considered but they are not persuasive. It is first noted that the instant claims are directed to a product and not a method/process of making the O/W emulsion. The instant amendment is a product by process limitation and according to the MPEP section 2113, "even though product by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production, if the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed.Cir. 1985). Secondly, it is should be noted that process limitations are only given weight when it yields a different product itself. The examiner points out that the instant process limitation does not provide for a different product from the prior art of record. The product yielded is the same: an O/W emulsion containing the all the required elements. Therefore, the product is not distinct form the prior art of record and the rejection is maintained.

Rejection of claims 4-23 and 26-29 under 35 U.S.C. 102(b) as being anticipated by Alban et al (5,318,774) is maintained.

Alban et al disclose a tanning o/w emulsion containing an aqueous phase, and oil phase, 0.50% ceteareth-12 and 0.05% ceteareth-20, and 3% dihydroxyacteone. See example IV. The oil and water phase contain other soluble substance.

Response to Amendments and Arguments

Applicant has amended the claims to recite that the O/W emulsion is obtained by phase inversion induced by varying the pH. Applicant argues that anticipation requires that each and every element is set forth in the claims either inherently or expressly and since the prior art of record does not teach the instant amendment, the art does not read on instant claims.

Applicant's arguments have been fully considered but they are not persuasive. It is first noted that the instant claims are directed to a product and not a method/process of making the O/W emulsion. The instant amendment is a product by process limitation and according to the MPEP section 2113, "even though product by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production, if the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed.Cir. 1985). Secondly, it is should be noted that process limitations are only given weight when it yields a different product itself. The examiner points out that the instant process limitation does not provide for a different product from the prior art of record. The product yielded is the same: an O/W emulsion containing the all the required elements. Therefore, the product is not distinct form the prior art of record and the rejection is maintained.

Rejection of claims 4-23 under 35 U.S.C. 102(b) as being anticipated by Ascione et al (5858334) is maintained.

Ascione et al disclose oil-in-water ultra-fine emulsions containing dihydroxyacetone. The cosmetic composition contains 3.3% cetylstearyl alcohol containing ethylene oxide and 5% dihydroxyacetone (see example 1 and col. 3 and 4, beginning on line 55). The oil and water phase contain other soluble substances.

Response to Amendments and Arguments

Applicant has amended the claims to recite that the O/W emulsion is obtained by phase inversion induced by varying the pH. Applicant argues that anticipation requires that each and every element is set forth in the claims either inherently or expressly and since the prior art of record does not teach the instant amendment, the art does not read on instant claims. Applicant argues that Ascione et al teach a phase inversion induced by temperature.

Applicant's arguments have been fully considered but they are not persuasive. It is first noted that the instant claims are directed to a product and not a method/process of making the O/W emulsion. The instant amendment is a product by process limitation and according to the MPEP section 2113, "even though product by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production, if the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed.Cir. 1985). Secondly, it is should be noted that process limitations are only given weight when it yields a different product itself. The examiner points out that the instant process

limitation does not provide for a different product from the prior art of record. Thus, applicant's argument that the Ascione obtains the O/W emulsion by temperature phase inversion rather than pH is moot since the product is the same, as also noted by applicant's specification pages 9 thorough 10. The product yielded is the same: an O/W emulsion containing the all the required elements. Therefore, the product is not distinct form the prior art of record and the rejection is maintained.

Conclusion

All rejections are maintained at this time and no claims are allowed

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharmila S. Gollamudi whose telephone number is 571-242-0614. The examiner can normally be reached on M-F (8:00-5:00) with every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SSG

April 9, 2004

MICHAEL G. HARTLEY
PRIMARY EXAMINER